UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/494,859	02/01/2000	Stephen R. Beaton	VTN-0458	4043

7590 04/30/2002

Audley A Ciamporcero Jr
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003

EXAMINER
FIDEI, DAVID

ART UNIT	PAPER NUMBER
3728	

DATE MAILED: 04/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/494,859	Applicant(s) BEATON ET AL.	
	Examiner David T. Fidei	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 February 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18 and 36-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18 and 36-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *14* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1-3, 5, 6, 17, and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Mangini et al (Patent no. 5,046,609). A packaging for housing at least one prescription product manufactured by a manufacturer and prescribed by a doctor comprising equivalent customized graphics HUCC that is the physicians name. Equivalent non-customized graphics are provided that identifies the manufacturer, see column 3 lines 47-48 on label 8, see figure 1.

As to claim 3, customized graphics are provided in addition to that already mentioned where the patient's name.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-7, 9, 17 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al (Patent no. 5,620,087) in view of Abrams (Patent no. 5,656,362) and Mangini et al (Patent no. 5,046,609). Martin et al discloses the claimed combination where "customized" and

"non-customized" information is provided on the lidstock of a contact lens container. The "customized" and "non-customized" information consists of a company name, logo, advertising or the like, see column 3, line 42 referring to Abrams (Patent no. 5,656,362). The difference between the claimed subject matter and Martin et al, if any, is that graphics are claimed for promoting a return visit to the doctor or advertises for the doctor.

Mangini et al discloses that it is old and well known in the art to provide prescription products with graphics providing the doctors name (thereby promoting the physician or clinic), patient or other related information. It would have been obvious to one of ordinary skill in the art to modify the packaging of Martin et al by employing graphics identifying the physician or patent, as taught by Mangini et al, in order to provide information preventing mix-ups and physician contact for further prescriptions.

The particular indicia used to convey this information, alphanumerical text or otherwise, is an obvious matter of design choice for the reason that the particular information conveyed in not changed by the system, language or medium used to convey and of no particular criticality.

5. Claims 7, 8, 10-12, 14, 15, 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al (Patent no. 5,620,087), Abrams (Patent no. 5,656,362) and Mangini et al (Patent no. 5,046,609) as applied to the claims above, and further in view of Abrams et al (Patent no. 5,697,495). Martin et al (Patent no. 5,620,087) discloses the claimed subject matter except for a secondary packaging.

Abrams (Patent no. 5,697,495) discloses that it is desirable in this art to provide a secondary packaging as shown in figure 1. It would have been obvious to one of ordinary skill in the art to provide a secondary packaging as taught by Martin et al (Patent no. 5,697,495), in order to provide a box for shipment or transportation of the contact lenses.

As to claims 14 and 15, to provide customized information printed on the carton would have been a matter of routine skill well within the level of ordinary skill, if for nothing else for providing shipment, identification and delivery of the products.

6. Claims 13, 16, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claims 11 and 14 above, and further in view of Vazquez (Patent no.

5,526,404). Martin et al discloses the claimed invention except for a label applied to the lidstock including identifying means. In as much as printing information onto a product or providing a label with such information is taken to be known to those skilled in the packaging art, well within the level of ordinary skill, Vazquez is cited to show a label applied to a product as a means of conveying information. Identifying means is also provided by bar code 13 as a means of recording and storing information through an optical scanner.

It would have been obvious to one of ordinary skill in the art to employ a label on the lidstock would have been an alternate manner of providing information on the carrier, in order to provide changeable indicia that can be individually structured. To employ identifying means on the label would have also been obvious for the reason of providing a system for storing/recording and accessing any information concerning the product.

7. Claims 18 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 1 above, and further in view of Hall (Patent no. 6,138,119). The difference between the claimed combination and the prior art resides in information provided that comprises pictures.

In as much as professionals such as real estate agents, dentists or doctors routinely provide picture with their advertisements, Hall figures 1 and 2 is cited for teaching the use of images 202e with advertisement as a means of data rights management, see column 10, lines 56 and 57.

It would have been obvious to one of ordinary skill in the art to employ customized information employing the physician's picture, in order to increase the promotional advertisement value.

Response to Amendment

8. Applicant's arguments filed February 27, 2002 have been fully considered but they are not persuasive.

Applicant considers the reference to Mangini et al (Patent no. 5,046,609) to be different from the claimed subject matter in that the printed matter is not produced by a printer but

transferred manually. However, the manner in which the information is produced is of no patentably distinction.

A "product by process" claim is directed to the product per se, no matter how actually made, In re Hirao, 190 USPQ 15 at 17(footnote 3). See also In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Fessmann, 180 USPQ 324; In re Avery, 186 USPQ 161; In re Wertheim, 191 USPQ 90; and In re Marosi et al, 218 USPQ 289, all of which make it clear that it is the patentability of the final product per se which must be determined in a "product by process" claim, and the an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. During examination, the patentability of a product-by-process claim is determined by the novelty and non-obviousness of the claimed product itself without consideration of the process for making it which is recited in the claim. In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985).

Any differences between applicant's claimed invention and Mangini et al reside not in the information conveyed, the meaning of information conveyed, the structure of the packaging per se but the manner in which the information may be applied (produced by a printer). As such these are not patentable distinctions. Furthermore, with respect to the indicia used to identify the physician or medical clinic, HUCC, it is clear this information does not appear manually applied but printed in some form.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov .

Any inquiry concerning the MERITS of this examination from the examiner should be directed to David T. Fidei whose telephone number is (703) 308-1220. The examiner can normally be reached on Monday - Friday 6:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached at (703) 308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line 1-800-786-9199
Internet PTO-Home Page http:www.uspto.gov/

David T. Fidei
Primary Examiner
Art Unit 3728

dtf
April 18, 2002